

REMARKS

1. Applicant thanks the Office for its remarks and observations, which have greatly assisted Applicant in responding.

2. **35 U.S.C § 103**

Under *Graham*, establishment of a *prima facie* case of obviousness requires resolution of the following factors:

1. the scope and content of the prior art;
2. the level of ordinary skill in the art;
3. the differences between the claimed invention and the prior art; and
4. objective evidence of nonobviousness.

Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966).

Claims 1, 3 and 6-25 are rejected as being unpatentable over Pricescan in view of U.S. patent no. 6,594,666 ("Biswas"). Applicant respectfully disagrees.

Applicant notes the improbable position taken by the Office that the claim elements being relied on to establish non-obviousness are non-limiting because they are listed in the Claim following a conditional element. Remarkably, the Office's position is that, because they are listed following the conditional elements, they are not executed unless the conditional elements are executed and therefore have no effect in determining patentability.

The plain language of the Claims clearly conveys to the ordinarily-skilled practitioner that the elements:

"integrating the at least one online provider with the at least one offline provider to provide an integrated list of providers for the item" and

"distinguishing online providers from offline providers in said integrated list . . ." are not conditional and that a search proceeds and an integrated list of providers is prepared whether or not the "conditions" are satisfied. Therefore, such claim elements are not properly excluded from a patentability analysis.

Applicant strenuously objects to the gratuitous and hyper-technical position the Office has devised to justify maintenance of a Final Rejection that Applicant has effectively demonstrated to be clearly improper. The concoction of such position, instead of responding to the issues Applicant has repeatedly raised, constitutes nothing less than an admission by the Office that the original grounds for the Final Rejection are improper.

Applicant further notes the Office's reference to positions articulated in the Office Actions of May 30, 2007 and January 25, 2008. Such reference, however, is pointless because those positions have either been overcome by amendment to the Claims or have been demonstrated to be improper.

Applicant also notes that even if the Office's position in relation to Claims 1 and 22 had any merit, which it does not, it would be meritless in relation to Claim 23 because the finding of conditionality cannot possibly apply to a system claim. The system either has the elements or it does not. The means for searching the database and for providing an integrated list of online and offline providers in response to a search request for a selected item and the means for distinguishing online providers from offline providers in said integrated list are elements of the system, no matter what. Their presence as elements within the claimed system is not conditional – they don't appear and disappear.

Additionally, even if the Office's position regarding Claim 23 were better reasoned, it would still be improper because it is apparent that the two functions are not conditional, preceding, as they do in the claim, the elements that the Office alleges are conditional.

In spite of the foregoing, Applicant amends Claims 1 and 22 to rearrange the claim elements. The reordered sequence conveys more clearly that at least one online and at least one offline provider of an item are identified and an integrated list of identified providers prepared wherein online and offline providers are distinguished from each other in the list, and that this occurs whether or not the two elements the Office alleges to be conditional occur. As Applicant has previously argued, there is no teaching or suggestion in the combination of the claimed subject matter. Support for the amendment is implicit in the Claims themselves. Accordingly, even if the newly-

devised ground of rejection were not improper, it would be overcome by the present amendment.

Regarding the ground of rejection put forward in the Office Actions of May 30, 2007 and January 25, 2008, which the Office still fails to effectively rebut, by withdrawing the previous ground of rejection and substituting another, the Office implicitly admits that the ground of rejection previously put forward is meritless.

Claim 23, as above, is deemed allowable without any further amendment.

In view of their dependence from allowable parent claims, the dependent Claims are deemed allowable without any separate consideration of their merits.

No new matter is added by way of the foregoing amendments. Such amendments are made only in the interest of advancing prosecution of the Application, in deference to the Office policy of compact prosecution. Such do not constitute agreement by Applicant with the Office's position. Nor do they reflect intent to sacrifice claim scope. In fact, Applicant expressly reserves the right to pursue patent protection of a scope it reasonably believes it is entitled to in one or more future submissions to the Office.

For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

CONCLUSION

In view of the foregoing, the Application is deemed to be in allowable condition. Accordingly, Applicant seeks favorable reconsideration and prompt allowance of the claims. Should the Examiner find it helpful, he is encouraged to contact applicant's attorney at 650-474-8400.

Respectfully submitted,



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